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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,036	06/14/2001	Hiroyuki Sekitani	010734	5953
38834	7590	05/01/2006	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			FADOK, MARK A	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 05/01/2006

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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/880,036  
Filing Date: June 14, 2001  
Appellant(s): SEKITANI, HIROYUKI

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Ryan B. Chirnomas  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3/3/2006 appealing from the Office action mailed 9/15/2005.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Claimed Subject Matter***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(8) Acknowledgement of the related Evidence Appendices**

Acknowledgement is present in the Brief

**(9) Acknowledgement of the related Proceeding**

Acknowledgement is present in the Brief

**(10) Evidence Relied Upon**

**5,146,404**

**Calloway**

**9-1992**

**(11) Grounds of Rejections to be Reviewed**

**USC 112 Sixth Paragraph Notification**

Applicant's non response to the previous request to indicated USC 112 intention is now considered prosecution history estoppel indicating that the applicant does not wish to invoke USC 112 6<sup>th</sup> paragraph.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Calloway et al (5,146,404).**

**In regards to claim 1**, Calloway discloses a part retrieving system for production machines utilizing a network (Abstract),  
the system being characterized in that the system comprises  
a part database (FIG 1A, item 37) and

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a terminal connected to the part database via a communication network for bidirectional communications with the part database (FIG 1B),  
said part database has information on parts accumulated therein (FIG 2A),  
the parts constituting each of production machines having different specifications (FIG 3A), and  
said terminal comprises:  
part information requesting means for requesting said part database to transmit the part information (FIG 2A),  
storage means for storing the part information transmitted in response to said transmission request FIG 1B), and  
retrieval means for retrieving parts from the stored part information depending on retrieval conditions (FIG 2A), and  
ordering means for creating order information depending on the result of the retrieval by said retrieval means (FIG 2C).

**In regards to claim 2**, Calloway teaches the system being characterized in that said part information requesting means transmits information including identification information on the individual production machines,

said database extracts, in response to said transmission request, information on parts concerning a production machine specified by said identification information and transmits the information as machine-specific part information comprising a group of pieces of part information on a specific production machine (FIG 2A,3A and 3B).

**In regards to claim 3**, Calloway teaches the system being characterized in that said transmission requesting means of said terminal causes display means provided in said terminal to display a plurality of pieces of identification information on said production machines as a machine selection menu so that a production machine can be selected from the displayed selection menu (FIG 2B).

### ***Response to Arguments***

Applicant argues that Calloway does not teach "a terminal connected to a parts database via a communications network for bidirectional communications with a part database." And further argues that "therefore, according to claim 1, the part database is not located in the local terminal. Thus, if the database of Calloway is located locally, rather than in the central computer, Calloway cannot anticipate the claims." The examiner disagrees and provides the following rationale.

1) Appellant was requested to notify the Office if USC 112 sixth paragraph was being invoked in a 7/29/2005 Office Action. Appellant did not respond to the request and the examiner noted this in the 9/15/2005 Office Action that the examiner took this to mean that Appellant was not invoking USC 112 6<sup>th</sup> paragraph, therefore, the examiner has considered the appellant's claimed features in there broadest reasonable interpretation.

2) Appellant's specification does not specifically define what the communications network, using terms like "such as" and "for example" to suggest how the network might be configured.

3) The examiner notes that in reference to FIG 1B of Calloway, the Local Database is clearly detached from the workstation computer (what the examiner is equating as appellant's terminal). Since the database is detached a connection such as a hard wire is required to connect the two devices. With this said, Microsoft Dictionary defines a "Communication Network" as a "network" and a Network is defined as "a group of computers and associated devices that are connected by communications facilities. A network can involve permanent connections such as cables, or temporary connections made through telephone or other communications links. A network can be as small as a LAN (local area network) consisting of a few computers, printers, and other devices, or it can consist of many small and large computers distributed over a vast geographic area (WAN or wide area network)." In the case of Callaway, there are at least two computers (possibly three if you consider the database to be its own computer), but even if this is not the case and the database is only a device connected

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to the work station computer (item 24) it is still connected over the network, the network that is the database, work station and central computer (see FIG 1B).

4) Furthermore, for arguments sake, consider that the local database is not on a network (which the examiner does not acquiesce), it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the database at any place on the network, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

For the above reasons, it is believed that the rejections should be sustained.

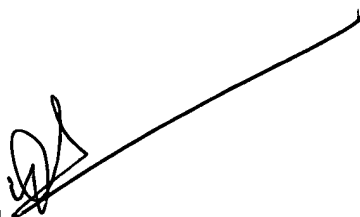
Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. Fadok', followed by a long horizontal line.

Mark Fadok  
Primary Examiner

April 26, 2006

Conferees

A handwritten signature in black ink, appearing to read 'Y. Garg', followed by a long diagonal line extending upwards and to the right.

Yogesh Garg  
Acting SPE AU 3625

A handwritten signature in black ink, appearing to read 'J. Weiss', followed by a long horizontal line.

John Weiss  
Appeals Specialist  
SPE AU 3629